



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/565,599

01/24/2006

Hideki Kurata

TIP001

2414

32628

7590

01/19/2011

KANESAKA BERNER AND PARTNERS LLP

1700 DIAGONAL RD

SUITE 310

ALEXANDRIA, VA 22314-2848

EXAMINER

KARLS, SHAY LYNN

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

01/19/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEKI KURATA

Appeal 2009-010113
Application 10/565,599
Technology Center 3700

Before RICHARD E. SCHAFER, JAMESON LEE, and
RICHARD TORCZON, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

A. STATEMENT OF THE CASE

This is a decision on appeal by an Appellant under 35 U.S.C. § 134(a) from a final rejection of claims 1 and 3-6. We have jurisdiction under 35 U.S.C. § 6(b). We *affirm-in-part*.

References Relied on by the Examiner

King	3,662,969	May 16, 1972
Mason	3,918,166	Nov. 11, 1975
Koizumi et al. ("Koizumi")	5,406,715	Apr. 18, 1995

The Rejections on Appeal

The Examiner rejected claims 1 and 3 under 35 U.S.C. § 102(b) as anticipated by Mason.

The Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Mason and King.

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over Mason, King, and Koizumi.

The Invention

The invention relates to a device, termed a "drain cleaner" for cleaning up water pooled on the floor of a location such as a construction site or factory. (Spec. 1: ¶ 0001.) Claim 1 is representative and is reproduced below:

1. A drain cleaner comprising:

an equal width strip body having two edges disposed along a longitudinal direction of the strip body and a handle at a front end of the strip body; and

a reel body having a rotary member to which a rear end of the strip body is attached and reeling in or playing out the strip body to or from the rotary member by rotating this rotary member;

wherein the strip body is provided with flexible members disposed on both edges of the strip body, the flexible members being configured to make close contact with an abutting surface along the long direction of the strip body.

B. ISSUES

1. Did the Examiner incorrectly find that Mason is an anticipating reference as it discloses all the limitations of the Appellant's claims 1 and 3?
2. Did the Examiner incorrectly determine that Mason is analogous art and thus available as prior art in evaluating the obviousness of the Appellant's claims 4-6?

C. PRINCIPLES OF LAW

Whether or not a reference constitutes analogous art is not relevant in an anticipation rejection. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). "A reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims." *Id.*

A reference qualifies as prior art in an obviousness determination only when it constitutes analogous art with respect to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

A reference constitutes analogous art if it is either (1) in the field of the applicant's endeavor, or (2) reasonably pertinent to the particular problem with which the inventor was concerned. *Id.*

A prior art reference is reasonably pertinent if it is one which logically would have commended itself to an inventor's attention in considering his problem. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

D. FINDINGS AND ANALYSIS

Anticipation

The Examiner rejected claims 1 and 3 as anticipated by Mason. The Appellant addresses each claim separately.

Claim 1

With respect to claim 1, the Appellant first contends that the Examiner's rejection is deficient because Mason, being directed to a head circumference measuring device, is "totally unrelated" to the "drain cleaner" set forth in its claim. (App. Br. 4:1-3.) We understand the argument as one based on an assertion that Mason constitutes non-analogous art.

That argument is misplaced. The rejection is one of anticipation under 35 U.S.C. § 102(b). Whether or not a reference constitutes analogous art is not a relevant inquiry in an anticipation rejection. *In re Schreiber*, 128 F.3d at 1478. Even if a prior art reference is from an entirely different field of endeavor than that of the claimed invention or is directed to an entirely different problem from the one addressed by the inventor, the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims. *Id.*

We recognize that claim 1 begins by reciting a "drain cleaner." The term sets forth only the intended function of the claimed invention and does not require any structural limitation other than those appearing in the body

of the claim. For instance, the term does not impose any size requirement. Although Mason's invention is described as a measuring device, the Appellant does not explain why Mason's measuring device would not also function as a drain cleaner.

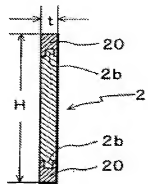
The Appellant contends that the claim feature of "flexible members" which are disposed on both edges of a strip body and which are "configured to make close contact with an abutting surface along the long direction of the strip body" is missing in Mason. (App. Br. 4:4-10; Reply Br. 2:12-19.) We disagree.

Mason is directed to a device for measuring the circumference of a person's head. (Mason Abstract.) In accounting for the above-noted claim feature, the Examiner determined that Mason's measuring tape 16 constitutes a strip body and the edges of elastic belt 14 located on either side of tape 16 form flexible members. (Ans. 5:20-6:5.) The Examiner reasoned that the edges of elastic belt 14 are configured to make contact with an abutting surface as required by the Appellant's claims.

In challenging the Examiner's determination and reasoning, the Appellant asserts that Mason does not disclose flexible members that are "configured" as required by its claim because the reference does not itself describe that any of the edges of its elastic belt are ever actually positioned so as to abut a surface. (Reply Br. 2:15-21.)

The Appellant's argument is unpersuasive. That Mason does not describe in words that the edges of its elastic belt about a surface does not mean the edges are not configured to do so.

In the context of the Appellant's specification, a flexible member along a strip body is configured to abut a surface, such as a floor, when the flexible edges of the member are arranged as components with a rectangular edge located at each end of the strip body. The Appellant's Figure 3



(reproduced on the right) depicts an embodiment of its invention having flexible members corresponding to those required by its claim 1. The figure illustrates a cross-section of strip body 2 having edges 20 formed of a flexible material such as rubber. (Spec. 4: ¶ 0011.)

Similarly, Mason's Figure 2 depicts a cross-section of its measuring device. Figure 2 (reproduced on the left) shows an elastic belt 14 made of rubber formed around measuring tape 16 and including ribs 20 as end edge portions disposed on both edges of the tape. (Mason 2:42-66.) The structural similarities between the flexible members of the Appellant's Figure 3 and the rubber ribs 20 of Mason's Figure 2 are notable. Those similarities support the Examiner's determination that Mason's rubber ribs are reasonably

viewed as flexible members with end edges which are structured and configured to make close contact with an abutting surface. The Appellant does not meaningfully explain why or how that determination is in error.

In the alternative, we note that the claim does not require that it must be the outermost edges of the flexible members which are configured to abut

a surface. Rather, any portion of the flexible members may be so configured. Mason's measuring device is configured to fit tightly around a person's head (Mason 2:57-60) and the ribs 20 of the device are arranged to prevent the edge of measuring tape 16 from cutting into a person's skin (*id.* at 3:5-6). The ribs are thus disclosed as flexible members that make close contact with an abutting surface, *i.e.*, a person's head.

For the foregoing reasons, we sustain the Examiner's rejection of claims 1 and 3 as anticipated by Mason.

Claim 3

Claim 3 is dependent on claim 1 and adds the feature that the "flexible members are rubber members." (App. Br. 9 Claims App'x.) The Examiner rejected claim 3 as anticipated by Mason. According to the Appellant, claim 3 is patentable over Mason for the same reasons that were advanced for claim 1. For the same reasons discussed above, we reject the Appellant's position.

The Appellant also asserts that claim 3 is patentable over Mason because of the "additional features it recites." (App. Br. 4:28-29.) The Appellant's assertion does not constitute an argument for the separate patentability of claim 3. 37 CFR § 41.37(c)(1)(vii) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.") In any event, Mason discloses that the elastic belt and its edges are made of rubber. (Mason 2:56-58.) The Appellant does not explain why the rubber edges of Mason's belt do not reasonably constitute the "rubber members" set forth in claim 3.

We sustain the rejection of claim 3 as anticipated by Mason.

Obviousness

The Examiner rejected claims 4 and 5 as unpatentable over Mason and King and claim 6 as unpatentable over Mason, King, and Koizumi. Claim 4 is an independent claim. Claims 5 and 6 depend from claim 4.

Claim 4

Claim 4 is drawn to a drain cleaner. As with claim 1, the Examiner relied on the teachings of Mason in rejecting claim 4. The Appellant contends that Mason is non-analogous art to its claimed invention directed to drain cleaners. A reference qualifies as prior art in an obviousness determination only when it is analogous to the claimed invention. *In re Bigio*, 381 F.3d at 1325. A reference is analogous art if it either is; (1) in the field of the applicant's endeavor, or (2) reasonably pertinent to the particular problem with which the inventor was concerned. *Id.*

The Appellant's field of endeavor is that of water removal devices. (Spec. 2:¶ 0006.) Mason discloses a device for measuring the circumference of a person's head. (Mason Abstract.) The measuring device is not disclosed as being used for collecting water nor are the edges of its device intended to operatively contact a surface, such as a floor, on which water may potentially pool. Mason's measuring device is simply mounted on a person's head and functions to measure its circumference. That is not a device falling within the Appellant's field of endeavor.

A prior art reference is reasonably pertinent if it is one which logically would have commended itself to an inventor's attention in considering his problem. *In re Clay*, 966 F.2d at 659. In this case, the problem faced by the inventor was in minimizing the number of workers required to operate a tool

for conveying pooled water from a surface. (Spec. pp. 1-2.) The record does not demonstrate any credible reason why a device which operates to fit around and measure a person's head, as in Mason, would have logically commended itself to an inventor intent on minimizing the number of required workers for moving pooled water on a surface. In our view, the intended functions of the devices of Mason and the Appellant's invention are so dissimilar as to preclude a determination that Mason is "reasonably pertinent" to the problem faced by the Appellant's inventor. The Examiner also has not articulated any rationale as to why Mason is reasonably pertinent to that problem.

We thus conclude that Mason constitutes non-analogous art and is not applicable as a prior art reference in evaluating the obviousness of the Appellant's claims. We do not sustain the rejections of claims 4-6 as obvious based on the teachings of Mason taken with one or more of King and Koizumi.

E. CONCLUSION

1. The Examiner did not incorrectly find that Mason is an anticipating reference as it discloses all the limitations of the Appellant's claims 1 and 3.

2. The Examiner incorrectly determined that Mason constitutes analogous art and thus available as prior art in evaluating the obviousness of the Appellant's claims 4-6.

F. ORDER

The rejection of claims 1 and 3 under 35 U.S.C. § 102(b) as anticipated by Mason is affirmed.

The rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Mason and King is reversed.

The rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over Mason, King, and Koizumi is reversed.

AFFIRMED-IN-PART

KMF

KANESAKA BERNER AND PARTNERS LLP
1700 Diagonal Road, Suite 310
Alexandria, VA 22314-2848